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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,387	02/27/2004	Pijush K. Dewanjee	PU2192	2386

23454 7590 11/30/2004

CALLAWAY GOLF COMPANY  
2180 RUTHERFORD ROAD  
CARLSBAD, CA 92008-7328

EXAMINER
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PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/708,387

Applicant(s)

DEWANJEE ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/27/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

This Office action is responsive to communication received 02/27/2004 – application papers filed.

Claims 1-20 are pending.

Following is an action on the MERITS:

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/605,535. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '535 application merely differ from the instant claimed invention in that the claims of the '535 device do not set forth a specific non-metal material, namely, a thermoplastic polyester polyurethane (hereinafter referred to as TTP) having a Shore D hardness ranging from 50-65, as claimed in the instant claims. The recitation of "non-metal material" in the

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'535 application claims is deemed to encompass the more limited recitation of a (TPP). Moreover, the skilled artisan, realizing the specific characteristics of a material that is to be used as a central member in an iron golf club head, would have been able to select a material that is best suited for the manner in which the central member is to function. In other words, if the central member is to be made of non-metal material that cushions the impact of a golf ball with the striking face, than one skilled in the art would have found it obvious to select a material having sufficient damping qualities. If on the other hand, the skilled artisan had desired to make use of a non-metal material for the purpose of reducing the overall weight of the club head, than one of ordinary skill in the art would have found it obvious to select a polymer material that exhibits strength and is lightweight in order to meet the design criteria for the club head. It is well established in the Patent Laws that the selection of a material to take advantage of its natural characteristics would have been an obvious design choice for the skilled artisan. See In re Hopkins 145 USPQ 140.

With respect to the remaining limitations in the instant claims and regarding instant claims 2-20, see claims 2-20, respectively, of the "535 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-7, 9 and 11-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/604,520. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '520

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application merely differ from the instant claimed invention in that the claims of the '520 device do not set forth a specific non-metal material, namely, a thermoplastic polyester polyurethane (hereinafter referred to as TTP) having a Shore D hardness ranging from 50-65, as required by the instant claims. The recitation of "non-metal material" in the '520 application claims is deemed to encompass the more limited recitation of a (TPP). Moreover, the skilled artisan, realizing the specific characteristics of a material that is to be used as a central member in an iron golf club head, would have been able to select a material that is best suited for the manner in which the central member is to function. In other words, if the central member is to be made of non-metal material that cushions the impact of a golf ball with the striking face, than one skilled in the art would have found it obvious to select a material having sufficient damping qualities. If on the other hand, the skilled artisan had desired to make use of a non-metal material for the purpose of reducing the overall weight of the club head, than one of ordinary skill in the art would have found it obvious to select a polymer material that exhibits strength and is lightweight in order to meet the design criteria for the club head. It is well established in the Patent Laws that the selection of a material to take advantage of its natural characteristics would have been an obvious design choice for the skilled artisan. See In re Hopkins 145 USPQ 140.

With respect to the remaining limitations in the instant claims and regarding instant claims 3-7, see claims 3-7, respectively, of the '520 application.

With respect to the remaining limitations in the instant claims and regarding instant claims 9 and 11-20, see claims 9 and 11-20, respectively, of the '520 application.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection over a pending application (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel \_\_\_\_\_, Frame \_\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From: \_\_\_\_\_ To: \_\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figure 4 in Best. Note Figure 4 in Takeda. Fisher shows a composite material for the face, of interest. Observe Figure 1A in Erickson. See Figure 3 in Cho. Note element (26) in Gilbert. Viljoen shows a medallion (32), of interest. Note the tabs or teeth (25) in Su. Note the perimeter tabs in Lo. Clausen et al shows an iron-type club head with a central member, of interest. See the tabs in Figure 9 of Helmstetter ('302) and ('661). See Figure 5 in Cameron.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
November 26, 2004

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: \_\_\_\_\_

Application No.: \_\_\_\_\_ Filed: \_\_\_\_\_

For: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_,  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the Patent and Trademark Office at  
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3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : \_\_\_\_\_

Name : \_\_\_\_\_

Title : \_\_\_\_\_

Signature: \_\_\_\_\_



PTO/SB/25 (10-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TERMINAL DISCLAIMER TO OBTAIN A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION</b>	Docket Number (Optional)
<p>In re Application of:</p> <p>Application No.:</p> <p>Filed:</p> <p>For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number _____, filed on _____, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> <div style="display: inline-block; width: 60%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: inline-block; width: 40%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> </div> <div style="text-align: center; margin-top: 5px;"> <div style="display: inline-block; width: 60%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: inline-block; width: 40%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> </div> <p style="text-align: center; margin-top: 5px;">Typed or printed name</p> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) is included.</p> <p style="text-align: center;"><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> <p><small>*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.</small></p>	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.